

REMARKS

In order to promote administrative efficiency and better communication, the Examiner is invited to make suggestions at any time during the proceedings, via phone, fax or e-mail, whenever such suggestions are within the Examiner's discretion as an aid to placing the claims in order for allowance in a timely manner. In this case, the Examiner's patience is requested as the original application as well as the PCT filing was prepared by the lead inventor without help of experienced counsel.

Priority--Examiner's Point 1

The Examiner rightly points out that Applicant claims the benefit of an earlier filing date under 35 USC 120, to a PCT application, however, the Examiner asserts that Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 USC 120. In response thereto, Applicant has amended the first sentence of the specification to make appropriate reference to the prior PCT application, including relationship.

Concerning the evidence of co-pendency with the PCT, Applicant provides a certified copy of the International Application, and a translation thereof. According to 35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application, *"if any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language."* Consequently, it is believed that Applicant has complied with this requirement.

Concerning the Examiner's request for a certified copy of the French priority filing, such copy is enclosed herewith. Safe receipt of this document is respectfully requested.

It is now believed that the application properly claims priority to such prior filed application. Acknowledgement thereof is respectfully requested.

Claim Objections—Examiner's Point 2:

The Examiner objected to claims 3-12 under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only--.

and/or, --- cannot depend from any other multiple dependent claim. Applicant has amended the claims appropriately, to remove the double multiple dependency. It is believed therefore that the claims are in a form acceptable for review by the Examiner.

Information Disclosure Statement—Examiner's Point 3:

In response to the Examiner's comment that a listing of references in the specification is not a proper information disclosure statement, Applicant attaches hereto a proper Information Disclosure Statement and requests that the Examiner fully consider such references and note such fact on the face of any patent that may be granted therefrom.

In the Drawings—Examiner's Point 4:

The Examiner objected to the drawings because they do not include the following reference sign(s) mentioned in the description:

References R, D, and d on page 7, lines 20-21, and
127m, 127f, and 127a on page 8, lines 5 and 9, of the specification.

Applicant attaches hereto corrected drawing sheets in compliance with 37 CFR 1.121(d). Note that Applicant has reworded the paragraph on page 7 which referred to reference R, D and d by removing such references. In addition, Applicant has amended the reference to 127a to read "127m". Therefore, it is believed that the objections of the Examiner are now overcome.

In the Specification—Examiner's Point 5:

The Applicant has amended the Abstract as suggested by the Examiner, as shown below:

~~The invention relates to a~~ A device (3) ~~that is~~ used to fit a nucleus prosthesis made up of comprising: a deformable elastic nucleus prosthesis (1) which can adapt to the shape of

intervertebral cavities, ~~said the~~ prosthesis consisting of two parts, namely a male part (11) and a female part (12); and an insertion assembly (2) which is connected to the nucleus prosthesis (1). The elastic deformation of the ~~inventive~~-nucleus prosthesis (1) makes it possible for the prosthesis to be inserted into the intervertebral cavity. ~~According to the invention, said The~~ prosthesis is inserted using the elasticity thereof and the insertion means (2) which form part of the device (3) before insertion, but which can be subsequently removed. ~~The invention also relates to different forms of prosthesis and insertion devices.~~

The Examiner objected to the Specification for not including reference numbers 4, 5, 22, 114, 125, 126, 127, 241 and 251. Applicant has amended the drawings to remove references 22, 114, 125, 126, 241 and 251. Applicant has amended the specification to refer to reference numbers 4, 5 and 127. Consequently, it is believed that the Specification is now fully compliant with the rules and the law. Acknowledgement of this fact is respectfully requested.

Claim Rejection under 112, Second Paragraph—Examiner's Point 6:

Concerning the Examiner's rejection under 112, Applicant believes that the above amendments to the claims overcome these rejections. The terms and sections which the Examiner identified as being indefinite for failure to distinctly claim the subject matter have been amended to more clearly define the invention. For example, the specification has been amended to correct the lack of antecedent basis.

Claim rejections: 102(b) Rejection based on Froning—Examiner's Point 7:

The Examiner rejected claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Froning (US Patent No. 3,875,595). Applicant traverses this rejection. Contrary to Examiner's contention, Froning does not at all disclose a "nucleus prosthesis for insertion in an intervertebral cavity, the prosthesis characterized in that it comprises a first and a second interlocking structural component, each made of a semi-rigid, deformable elastic material suitable for supporting a compressive load; and in that, the *second structural component inserts into the first structural component.*" Identity in the elements of the claims must be found in a single prior art reference to support a §102 rejection. It cannot be fairly said that Froning includes a second structural component (41, socket members, see Col. 2, line 60 of

Froning) that inserts into the first structural component (46, the prosthesis, see e.g. Col. 2, line 57). Although, in Applicant's view, it can be fairly said that the prosthesis 46 inserts *between* the socket members 41, it cannot be said that either component inserts *into* another analogous component. To interpret the claims otherwise would be to deprive the words of their ordinary meaning and their meaning in light of Applicant's disclosure, which clearly shows one component 11 inserting inside, or substantially within confines of an envelop defined between the outermost surfaces of the component 12. Therefore, Applicant respectfully requests that this reference be removed and the claims as amended be passed to allowance.

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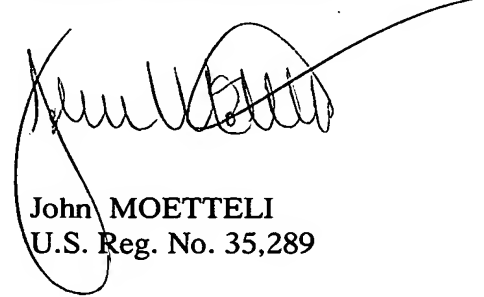
Conclusion : Examiner's Point 8

Applicant has made a diligent effort to advance the prosecution of this application by cancelling claims, by amending claims, and by pointing out herein with particularity how the claims now presented are patentably distinct from the prior art of record. Therefore, Applicant respectfully submits that the claims, as amended, are now in condition for allowance. No new matter has been entered by this amendment. Any limitations to the claims are made solely for the purpose of expediting the prosecution of the application and, unless otherwise expressly stated, are not made to narrow, vis-à-vis the prior art, the scope of protection which any subsequently issuing patent might afford.

The Undersigned authorizes the Commissioner to charge any fee or credit any overpayment of any fee under 37 CFR §1.16 and §1.17 which may be required in this application to the deposit account of MOETTELI & ASSOCIES SARL, no. 50-2621.

Again, if the Examiner has further questions, she is invited to contact the Undersigned at phone 011-4171-230-1000, fax at 011-4171-230-1001 (Switzerland is 6 hours ahead of Eastern Std Time), or e-mail at **moetteli@patentinfo.net**.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John Moetteli', is written over a circular stamp. The signature is fluid and cursive.

John MOETTELI
U.S. Reg. No. 35,289

Date : January 18th, 2006

Enclosure: replacement abstract
Certified copy of priority document
Certified copy of International Application
Information Disclosure Statement
Corrected drawing sheets in compliance with 37 CFR 1.121(d).
Petition to Revive Unintentionally Abandoned Application